REMARKS

1. In response to the Office Action mailed July 27, 2010, Applicant respectfully requests reconsideration. Claims 1-33 and 58 were last presented for examination. In the outstanding Office Action, claims 1-33 and 58 were rejected. No claims have been amended, added or cancelled. Upon entry of this paper, claims 1-33 and 58 will remain pending in this application. Of these thirty-four (34) claims, 3 claims (claims 1, 16 and 58) are independent.

2. Based upon the following Remarks, Applicant respectfully requests that all outstanding objections and rejections be reconsidered, and that they be withdrawn.

Claim Rejections under §103 – Jeutter in view of Kung

3. Claims 1-4, 11, 12, 16-19, 28, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,314,453 to Jeutter in view of U.S. Patent No. 6,366,817 to Kung. Applicant respectfully requests reconsideration for at least the following reasons.

The proposed combination of Jeutter and Kung does not contain all elements of Applicant's claims

4. Independent claim 1 recites, in part, "measuring the strength of a magnetic field proximal to the external transceiver, wherein the magnetic field is generated at least in part by the external transceiver…." (*See,* Applicant's claim 1, above.) Applicant respectfully submits that none of the cited references teach or render obvious this limitation of claim 1.

5. In order to establish a *prima facie* case of obviousness, it is well established that "the Examiner must show that each and every limitation of the claim is described or suggested by the prior art or would have been obvious based on the knowledge of those of ordinary skill in the art." (*See e.g., Ex Parte Hans-Wilm,* 2009 WL 4695166, *2 (Bd.Pat.App. & Interf. December 4, 2009), citing, *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988)).

6. In Applicant's prior response, Applicant noted that, as recently explained by the Board of Patent Appeals and Interferences (BPAI), "if the proposed combination would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed combination." (Ex Parte Donovan, 2009 WL 4702439, *4

(BPAI December 3, 2009), *citing In re Gordon*,733 F.2d 900, 902 (Fed. Cir. 1984), *emphasis added*.)

7. Applicant further pointed out the proposed combination of Jeutter and Kung would render the prior art invention unsatisfactory for its intended purpose. In the outstanding Office Action, the Examiner alleged that the proposed combination of Jeutter and Kung would not be rendered inoperable because the Examiner is alleging that the proposed combination indicates that "it would be obvious to combine means for measuring the strength of a magnetic field …with an external device that can generate a magnetic field and an internal device that can sense a magnetic field and determine a parameter of said field…." (*See*, Office Action, pg. 3.)

8. Applicant's claim 1, however, recites "measuring the strength of a magnetic field proximal to the external transceiver, wherein the magnetic field is generated at least in part by the external transceiver." (*See*, Applicant's claim 1, above.) Thus, even assuming the proposed combination would not render Jeutter inoperable, the proposed combination still does not include "measuring …. proximal to the external transceiver…," as recited in Applicant's claim 1.

9. In other words, the proposed combination relied on by the Examiner includes "an internal device that can sense a magnetic field and determine a parameter of said field." (*See*, Office Action, pg. 3.) Applicant's claim 1, however, does not claim the internal device measuring the strength of the magnetic field. Rather, Applicant's independent claim 1 recites "measuring the strength of a magnetic field *proximal to the external transceiver*." (*See*, Applicant's claim 1, as amended.)

10. As such, even if the proposed combination would not render the invention of Jeutter inoperable, the proposed combination still fails to show that each and every limitation of Applicant's claim is described or suggested by the prior art or would have been obvious based on the knowledge of those of ordinary skill in the art. Applicant's therefore respectfully request that the Examiner reconsider and withdraw the rejection to claim 1 for at least this reason.

11. Independent claim 16 recites, in part, "[a]n apparatus … comprising: means, for measuring the strength of a magnetic field proximal to the external transceiver, wherein the

magnetic field is generated at least in part by the external transceiver." Applicant respectfully requests that the Examiner reconsider and withdraw the rejection of independent claim 16 for at least similar reasons to those discussed above.

Claim Rejections under §103 – Chen in view of Kung

12. Claims 1-7, 11-22 and 28-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen in view of Kung. Claims 8-10, 23-27, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen in view of Kung as applied to claim 1 above, and further in view of U.S. Patent Application Publication No. 2003/0074035 to Bornhoft et al. (hereinafter, "Bornhoft"). Applicant respectfully requests that the rejection be reconsidered and withdrawn for at least the following reasons.

13. In the Office Action, the Examiner relied on the identical basis for combining Chen and Kung as the Examiner relied on for allegedly supporting a combination of Jeutter and Kung. As such, even if combining Kung with Chen would not render Chen unsatisfactory for its intended purpose, the Examiner's proposed combination does not include each and every limitation of Applicant's independent claims 1 and 16. Applicant therefore respectfully requests that the rejection of independent claims 1 and 16 be reconsidered and withdrawn.

Claim Rejections of Claim 58 under §102 or §103

14. Claim 58 is rejected under 35 U.S.C. 102(b) as anticipated by U.S. Patent No. 6,138,681 to Chen et al. (hereinafter, "Chen"), or in the alternative under 35 U.S.C. §103(a) as obvious over Chen.

15. Independent claim 58, as amended, recites "means for indicating that the external transceiver has been displaced *when the measured strength* of the magnetic field proximal to the external transceiver *is greater than the threshold value*." (*See*, Applicant's claim 58, above, emphasis added).

16. In the Office Action, the Examiner recognize that Chen discloses "determining that the device is displaced when a measured strength ***is less than a threshold value***." (See, Office

Action, pg. 3, emphasis added). The Examiner, however, argues that this teaching renders Applicant's claim obvious because "this determining is done for the same purpose and solves the same problem...." (*See*, Office Action, pg. 3.) Applicants disagree.

17. Applicant's claim limitation is not simply a design choice. But, is radically different from the system of Chen and provides an advantage over the system of Chen. As previously noted, in Chen, the magnetic field is generated by internal magnets. As such, when the internal and external units are separated, the sensed magnetic field will drop. As such, Chen could only detect that the internal and external units are separated if the magnetic field fell below a threshold.

18. In contrast, claim 58 recites "means for indicating that the external transceiver has been displaced *when the measured strength* of the magnetic field proximal to the external transceiver *is greater than the threshold value* and not if it exceeded a threshold." (*See*, Applicant's claim 58, above.) The system of Chen is quite different in that the sensed magnetic field in Chen will drop, not increase, as the internal and external units become separated.

19. Moreover, Applicant's invention of claim 58 provides a distinct advantage over that of Chen in that the invention recited in Applicant's claim 58 allows for the actual field between the transmitter and the receiver to be measured. Measurement of this field provides an improved mechanism for detecting whether the internal and external transceivers are properly aligned. Particularly, measuring the strength of the magnetic field itself provides a more reliable measure of whether communications can take place may between the internal and external transceivers. When measuring the actual magnetic field between the transmitter and receiver, the strength of the field proximal to the external transceiver will increase (not decrease) as the external and internal units become separated. As such, the cited limitation of Applicant's independent claim 58 is not a mere design choice but provides specific advantages over that of the prior art.

20. Applicant therefore respectfully submit that the assertion that "means for indicating that the external transceiver has been displaced when the measured strength of the magnetic field proximal to the external transceiver is greater than the threshold value," is a mere design choice

is without merit. As such, Applicant request that the Examiner reconsider and withdraw the rejection of claim 58 for at least this reason.

Dependent claims

21. The dependent claims incorporate all the subject matter of their respective independent claims and add additional subject matter which makes them independently patentable over the art of record. Accordingly, Applicant respectfully asserts that the dependent claims are also allowable over the art of record.

Conclusion

22. In view of the foregoing, this application should be in condition for allowance. A notice to this effect is respectfully requested.

23. Applicant reserves the right to pursue any cancelled claims or other subject matter disclosed in this application in a continuation or divisional application. Any cancellations and amendments of above claims, therefore, are not to be construed as an admission regarding the patentability of any claims and Applicant reserves the right to purse such claims in a continuation or divisional application.

Dated: October 7, 2010

Respectfully submitted,

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